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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,944	02/04/2002	Ezequiel Mejia	135695/0055	5578
7590 08/24/2004				
STROOCK & STROOCK & LAVAN LLP		EXAMINER		
180 Maiden Lane		VANNUCCI, JAMES		
New York, NY 10038-4982				
		ART UNIT	PAPER NUMBER	
		2828		
DATE MAILED: 08/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,944

Applicant(s)

MEJIA ET AL.

Examiner

Jim Vannucci

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al.(4,727,360) in view of Stafford et al.(5,482,008).

Claim 1, figure 1A of Ferguson discloses a magnetic ferrite core(10) for use in a passive integrated transponder tag(abstract) extending substantially the entire length of a transponder tag. Ferguson does not disclose the core comprising a coil receiving portion and an electronics support portion. Figure 15 of Stafford discloses a core(34) with a receiving coil portion(6) and an electronics(5) support portion for a smaller device like a tag(col. 5, lines 42-64).

Claims 2 and 6, figure 15 of Stafford discloses an electronics support portion that is adapted to support an integrated circuit(5) connected to an antenna coil(6).

Claim 3, figure 11 of Stafford discloses an electronics support portion further comprising a card with a metalization layer(33) formed therein or thereon.

Claim 4, figure 11 of Stafford discloses the electronics support portion further comprises one or more metal pads formed therein or thereon(not numbered, connection points).

Claim 5, figure 15 of Stafford discloses an antenna coil(6) wound about said coil receiving portion and electronically connected to a metalization layer or a metal pad formed on or in said electronics support portion.

Claim 7, figure 11 of Stafford discloses an integrated circuit(5) and antenna coil(6) which are each electrically connected to said metalization layer or metal pad(33).

Claim 8, integrated circuit flip-chip technology is well known in the art and its use with the disclosed device would be an obvious modification of the device(summary of invention portion of applicant's specification).

Claim 9, the IC(5) disclosed in Stafford would include a surface mounted capacitor thereon.

Claim 10, the core(34) disclosed in Stafford is made of ferrite.

Claim 11, figure 15 of Stafford discloses an encapsulation(80) means enclosing the core(34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the coil and core disclosed in Stafford with the tag disclosed in Ferguson so the device can be made smaller.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,400,338. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application are a mostly broader version of the claims recited in U.S. Patent No. 6,400,338.

Claim 1, claim 1 of '338 recites a core for use in a passive integrated transponder tag extending substantially the entire length of a transponder tag comprising a coil receiving portion and an electronics support portion.

Claims 2 and 6, claim 1 of '338 recites an electronics support portion that is adapted to support an integrated circuit connected to an antenna coil.

Claim 3, claim 2 of '338 recites an electronics support portion further comprising a card with a metalization layer formed therein or thereon.

Claim 4, claim 4 of '338 recites a PCB which would have one or more metal pads formed therein or thereon.

Claims 5 and 7, claims 7-9 of '338 recite an antenna coil wound about said coil receiving portion and electronically connected to a metalization layer or a metal pad formed on or in said electronics support portion.

Claim 8, the recited limitations are not considered because of the above 35 USC 112 rejection.

Claim 9, claim 10 of '338 recites a surface mounted capacitor thereon.

Claim 10, claim 3 of '338 recites a core made of ferrite.

Claim 11, claim 6 of '338 recites an encapsulation means enclosing the core.

Terminal Disclaimer

5. The Terminal Disclaimer filed on June 25, 2004 is not proper because it was signed by registration number 43,531 who is an attorney or agent, not of record and consequently is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Response to Arguments

6. Applicant's arguments filed June 25, 2004 have been fully considered but they are not persuasive.

The claims do not recite a cylindrical portion for receiving the antenna coil at one end and a flattened portion for permitting or housing the electrical connection.

The claims do not recite limitations concerning the metalization layer being formed to ferrite. Claim 1 recites "A core of magnetic ferrite", but this does not mean that the core is exclusively of ferrite, only that it is part ferrite. While the core may comprise an electronics support portion, it is not recited that the electronics support portion is

made from ferrite. Consequently, the limitation "electronics support portion further comprises a metalization layer formed thereon" does not require the metalization to be formed on a ferrite support.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jim Vannucci whose phone number is (571) 272-1820.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center whose telephone number is (703) 308-0956.

Papers related to Technology Center 2800 applications only may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center Fax Center number is (703) 872-9306.



James Vannucci